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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,227	03/16/2004	Raymond Saluccio	SALUCCIO 3.0-004	2015

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01/09/2007

EXAMINER

HAQ, NAEEM U

ART UNIT

PAPER NUMBER

3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/801,227

Applicant(s)

SALUCCIO, RAYMOND

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 1/4/2007
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to the Applicant's preliminary amendment filed on September 23, 2005. New claims 16-23 have been added. Claims 1-23 are pending.

Election/Restrictions

- I. Claims 1-6 and 8-23, drawn to a method and system for designing a promotion product that selects a filler to be inserted into a bottle, classified in class 705, subclass 26.
- II. Claim 7, drawn to a system for ordering a container that generates and records order history and order status, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method and system for designing a promotion product that selects a filler to be inserted into a bottle and does not require generating and recording order history and order status as required in invention II. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Ezra Sutton on January 4, 2007 a provisional election was made without traverse to prosecute the invention of Group I (claims 1-6 and 8-23). Affirmation of this election must be made by applicant in replying to this Office action. Claim 7 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claim 1 is objected to because of the following informalities: This claim recites "A **system** on the..."(emphasis added). However, the examiner notes that the body of the claim is directed to steps of a method. Furthermore, claims 2 and 3 are dependent on claim 1 and directed to a "method". Therefore, it appears that there is a typographical error in claim 1. This claim should be directed to a "method" and not a "system". For this reason, the examiner will treat claim 1 as a method claim.

Appropriate correction is required.

Specification

The preliminary amendment filed September 23, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the

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invention. The added material which is not supported by the original disclosure is as follows: The original specification (filed on March 16, 2004) does not provide written support for the term "simulated".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 8-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The term "simulated" lacks written description support in the original specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 and 8-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2, 6, 9, 10, 13, 20, and 21, the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Referring to claims 1-6 and 8-23, the phrase "simulated prescription bottle" and "simulated prescription label" renders the claim indefinite. It is unclear to the examiner how a "simulated prescription bottle" differs from any other bottle and how a "simulated prescription label" differs from any other label. For examination purposes, the examiner will assume these phrases refer to any type of bottle and any type of label.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso (US 6,857,211 B2) in view of Bryant (GB 2342203 A) and further in view of Henson (US 6,167,383).

Referring to claim 1: Grasso discloses a method for designing a product in the form of a simulated prescription bottle containing a promotional message (col. 2, lines 9-16), the method comprising:

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- preparing a simulated prescription label containing thereon a customized promotional message for promoting a product (col. 2, lines 9-30; Figure 1A and 1B);
- attaching said simulated prescription label onto a simulated prescription bottle for promoting said product (col. 2, lines 31-43).

Grasso does not teach selecting a filler to be inserted into said simulated prescription bottle. However, Bryant discloses a drug packaging method that selects a drug (i.e. filler) to be packaged (i.e. inserted) into a container (Abstract). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bryant into the invention of Grasso. One of ordinary skill in the art would have been motivated to do so in order to fill the pharmaceutical container of Grasso. The cited prior art does not teach ordering said simulated prescription bottle, message, and said filler over the Internet. However, Henson discloses a method of ordering a configured product over the Internet (Abstract). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Henson into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to increase sales volume by harnessing the power of the Internet.

Referring to claim 2: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. Furthermore, Grasso teaches that the product selected for promotion on the label is a wine product (col. 2, lines 25-30).

Referring to claim 3: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. Furthermore, Bryant teaches filler selected for inserting into the package (i.e. container) is a drug (Abstract). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bryant into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to fill the pharmaceutical container of Grasso.

Referring to claims 4 and 5: Grasso discloses a method for designing a product in the form of a simulated prescription bottle containing a promotional message (col. 2, lines 9-16), the method comprising:

- preparing a simulated prescription label containing thereon a customized promotional message for promoting a product (col. 2, lines 9-30; Figure 1A and 1B);
- attaching said simulated prescription label onto a simulated prescription bottle for promoting said product (col. 2, lines 31-43).

Grasso does not teach selecting a filler to be inserted into said simulated prescription bottle. However, Bryant discloses a drug packaging method that selects a drug (i.e. filler) to be packaged (i.e. inserted) into a container (Abstract). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Bryant into the invention of Grasso. One of ordinary skill in the art would have been motivated to do so in order to fill the pharmaceutical container of Grasso. The cited prior art does not teach ordering said simulated prescription bottle, message, and said filler over the Internet. However, Henson discloses a method of

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ordering a configured product over the Internet (Abstract). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Henson into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to increase sales volume by harnessing the power of the Internet. The cited prior art does not teach that the message is an emotional message for expressing an emotion. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of the method would be the same regardless of the message printed on the label. The differences between the content of the Applicant's message and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any content in the message of the cited prior art because such information does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 6, 10, 13, 18, and 21: Claims 6, 10, 13, 18, and 21 are rejected under the same rationale as set forth above in claim 3.

Referring to claims 8, 14, and 19: Claims 8, 14, and 19 are rejected under the same rationale as set forth above in claim 1.

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Referring to claim 9: Claim 9 is rejected under the same rationale as set forth above in claim 2.

Referring to claims 11, 15, 16, 20, 22, and 23: Claims 11, 15, 16, 20, 22, and 23 are rejected under the same rationale as set forth above in claim 4.

Referring to claims 12 and 17: Claims 12 and 17 are rejected under the same rationale as set forth above in claim 5.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Naeem Haq', with a stylized, cursive script.

Naeem Haq, Primary Examiner
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January 4, 2007